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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/088,163 06/01/98 MOSER, JR

J 960514.ORI

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EXAMINER

MILLER, E

ART UNIT

PAPER NUMBER

3641

DATE MAILED:

03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/088,163

Applicant(s)

MOSER, JR, JOHN R.

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 38-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradford et al. in view of Chi et al., Willer and Fleming, for reasons et forth in paragraph 2 of Paper No. 6, incorporated herein by reference.
3. Claims 38-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite. The recited "the uncured prepolymer" in claim 38, e.g., has no antecedent basis, and similarly in claims 43 and 53. Further, the terminology now used is indefinite and not properly supported as the specification is to a hydroxy terminated adipate polymer, but the broad recitations of the claims do not recite this. Specifically, the language is neutral as to termination, which is incorrect, especially in claims that recite isocyanate curing agents. As now set forth, claim 38 recites elongation of at least 200%, while dependent claims 42 recites only at least 170%. This is inconsistent, and broader than or different from the broad recitation in the independent claim. These remain exemplary.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 38-64 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 38 and 42 as amended, a new elongation limitation is added, but there

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is no basis therefore, or at least such basis has not been pointed out. Applicants are required to point out the basis for these limitations or to cancel them. The other claims are based on a specification and claims which contains new matter.

6. Claims 43-44 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voigt in view of Warringer et al.

Voigt teaches a composition of Estane binder dissolving TNT, e.g. Note col. 3, lines 1-5, e.g. for this polymer of isocyanate cured polytetramethyleneadipate. Some of the composition is a small amount of DNT impurity, which acts as a plasticizer. This renders the claims obvious. Warringer et al. further teach a composition with Estane binder, which is obvious, and obvious with a minor amount of plasticizer, e.g. Arguments of additional ingredients in the composition or in the polymer are not convincing of error, in view of the “comprising” scope of the claims. Claim scope, “comprising” vs. “consisting essentially of” is discussed in *In re Janakirama-Rao*, 137 USPQ 893 (CCPA 1963), and *Ex parte Davis*, 80 USPQ 448 (PO BA 1948) cited therein, on this fundamental, long settled question. Briefly, “comprising” scope does not exclude ingredients, even those which change the basic and novel characteristics of the claimed composition.

7. Claims 38-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton et al. in view of Hauser et al., Godfrey, Genetti et al., and Kangas.

Sutton et al. teach the basics of polyester polymer binders, e.g., at col. 4, lines 52-75. It would have been obvious to use a similar polyol, as well known in this art, as in the polyester art, col. 4, line 63. Hauser et al. clearly suggests the use of tetramethylene glycol, at col. 2, line 16, and substitution of such would have been obvious to one of ordinary skill in the art. Godfrey is primarily cumulative, but with a specific teaching of curing catalysts when carboxy terminated polyesters are used. Genetti et al., col. 5, line 67 through col. 6, line 15, e.g., and Kangas, at col. 4,

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lines 56-60 and col. 5, lines 1-2, 6, and 13, further show that the polyester itself is well known in the polymer art, e.g. Variation of specific, notoriously well known parameters would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

Applicant's arguments are essentially that the same composition is not taught, which is correct in that the rejection is under section 103 of 35 U.C.S., not section 102. That the polymer ingredients are suggested and closely related, even homologs, as in Hauser et al. above, is overlooked in the arguments. Substitution of such would have been obvious to one of ordinary skill, absent unexpected results. Compare *In re Riden*, 138 USPQ 112, e.g.


8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached daily, except alternate Fridays, from about 9 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Jordan can be reached at (703) 306-4159. The Group fax number is (703) 305-7687. If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
March 12, 2001



EDWARD A. MILLER
PRIMARY EXAMINER